

IN THE UNITED STATES DISTRICT COURT  
FOR THE WESTERN DISTRICT OF TEXAS

M.E.A.C. ENGINEERING LTD,

Plaintiff,

vs.

SOLVENTUM CORPORATION

Defendant.

**Case No.: 5:23-cv-01256-XR**

**Honorable Xavier Rodriguez**

**AGREED MOTION TO STAY PENDING *INTER PARTES* REVIEW**

Defendant Solventum Corporation and Plaintiff M.E.A.C. Engineering Ltd. jointly submit this agreed motion to stay this litigation pending the resolution of *inter partes* review (“IPR”) petitions filed by Solventum on June 5, 2024 and which are currently pending before the Patent Trial and Appeals Board (“PTAB”).

In support of this motion, the parties state as follows:

1. M.E.A.C. filed this case on October 25, 2023. (Dkt. 1.)
2. In its Complaint, M.E.A.C. asserts that Solventum infringes U.S. Patent Nos. 8,506,554 (“the ’554 patent”) and 8,858,534 (“the ’534 patent” or, collectively with the ’554 patent, the “Asserted Patents”). (Dkt. 1.)
3. On June 5, 2024, Solventum filed two IPRs challenging the validity of each claim of the ’534 patent and claims 12-17 and 26-27 of the ’554 patent.
4. Due to the timing requirements of 35 U.S.C. § 314 and 37 C.F.R. § 42.107, the PTAB’s institution decision is expected within approximately six months from the filing date of the IPR petitions.
5. Due to the timing requirements of 35 U.S.C. § 316, the PTAB’s final written decision is expected no later than twelve months from its institution decision.

6. During the status hearing before this Court on May 7, 2024, Plaintiff M.E.A.C. Engineering Ltd. stated that it would agree to stay the case pending Solventum's IPR petitions. Exhibit A, May 7, 2024 Hearing Tr. at 8:25-9:3 ("THE COURT: . . . So in the event that they do go off on their invalidity challenge to the PTAB, do you agree to a stay or not? MR. LUND [M.E.A.C.'s counsel]: Yeah. M.E.A.C. can be agreeable to that."). This Court thereafter indicated that it would suspend the current scheduling order and grant the parties' joint motion to stay, once filed. *Id.* at 9:4-7, 10:4-6.

7. The patents at issue in the IPRs are the same patents that are asserted by M.E.A.C. in this case and thus, the result of the PTAB's decision regarding the IPRs may affect the parties' respective positions in this case.

8. This case is in its early stages and to date, neither party has served discovery requests.

9. The parties agree that they would not be prejudiced by a stay pending resolution of the IPR proceedings.

10. This Court has inherent power to manage its docket and stay proceedings pending a determination by the United States Patent and Trademark Office. *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1426-27 (Fed. Cir. 1988).

Accordingly, for the foregoing reasons, Solventum and M.E.A.C. jointly request that the Court enter a stay pending resolution of the IPRs filed on the Asserted Patents.

Dated: June 12, 2024

Respectfully submitted,

**WHITESTONE LAW**

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**CERTIFICATE OF SERVICE**

I hereby certify that on June 12, 2024, I electronically submitted the foregoing document with the clerk of the court for the U.S. District Court, Western District of Texas, using the electronic case filing system of the court, which will effect service of the foregoing on the following via the CM/ECF system:

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